

### **REMARKS/ARGUMENTS**

In the specification, paragraphs [0006], [0022], [0034], [0035]-[0037], [0039], and [0056] have been amended and new paragraphs [0057.1]-[0057.10] from pages 11-16 of U.S. Provisional application No. 60/201,193, filed May 2, 2000 and entitled Traction Module incorporated by reference in paragraph [0057] in the present application have been added. These amendments have been made to correct minor editorial errors.

In amended Figures 5, 7, 8, 10, and 16, the previously omitted element numerals 162a,b, 102a,b, 122a,b, 166a, 168; 402 and 404 have been added. Numerals have been added to Figures 17-18. No new matter has been added.

Claims 1-11 remain in this application.

The examiner acknowledged that claim 10 is directed to allowable subject matter. Claims 12-14 have been withdrawn as the result of an earlier restriction requirement.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 12-14 in a divisional application.

### **I. DRAWINGS**

The examiner objected to the drawings stating that Figures 16-18 do not contain any reference numbers that the examiner considers necessary for a complete understanding of the claimed invention. Applicant has added reference numerals 403 and 404 to Figure 16 and has added reference numerals to Figures 17 and 18 based on the disclosure from pages 11-16 of U.S. Provisional application No. 60/201,193, filed May 2, 2000 and entitled Traction Module incorporated by reference in paragraph [0057] in the present application. New paragraphs [0057.1]-[0057.10] from pages 11-16 of U.S. Provisional application No. 60/201,193, filed May 2, 2000 and entitled Traction Module incorporated by reference in paragraph [0057] in the present application have also been added for the description of the newly added reference numerals. No new matter has been added. In view of these amendments, Applicant respectfully submits that Figures 16-18 are now in proper form.

The examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) stating that they do not include the following reference signs mentioned in the description: 102a, 102b, 122a, 122b, 140a, 140b, 142a, 142b, 162a, 162b, 158a, 158b, 166, 124, 118, 158, and 402.

Applicant amends the drawings and the specification as above in accordance with the examiner's objections. Reference numeral 162 in Figure 5 has been changed to 162a,b. Reference

numerals 102a,b have been added to Figure 7 and Reference numerals 122a,b have been added in Figure 8. Likewise reference numerals 168 and 166a have been added to Figure 10. The specification has been amended to refer to reference numeral 140 and 142 instead of 140a,b and 142a,b so that the specification conforms to the drawings. Likewise the specification has been amended to reference numerals 124a,b, 118a,b, 158a,b, and 166a,b. Applicant respectfully submits that the drawings are now in proper form.

The examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) stating that they include the following reference signs not mentioned in the description: 152 and 168.

Applicant respectfully submits that paragraph [0035] describes reference 152 by stating, "It can be seen in assembling end member 78 and medial member 82, end 150 of end member 78 is aligned with end 152 of medial member 82 such that the track pair 98 is aligned with track pair 140 such that end member 78 is slid onto medial member 82."<sup>1</sup> Paragraph [0037] by stating "Medial member 82 has recesses, such as recess 168, for housing one end of springs 166."<sup>2</sup> Applicant respectfully submits that the drawings are in proper form.

## II. SPECIFICATION

The examiner objected to the disclosure stating that the use of the trademark KEVLAR has been noted and should be capitalized wherever it appears and be accompanied by the generic terminology.

Applicant has amended the specification as described above to capitalize all uses of the term KEVLAR in accordance with the examiner's suggestions. Applicant respectfully submits that this rejection has now been overcome.

## III. CLAIM OBJECTIONS

Examiner objected to claim 7 because "extend" in line 2 should be changed to --extends--. Applicant has amended claim 7 per the examiner's suggestion. Applicant respectfully submits that the claim is in condition for allowance.

Examiner objected to claim 10 because of the recitation of "a propulsion housing" in line 2. Examiner stated that the preamble of claim 10 indicates that an anchoring system is being claimed and it is unclear how a propulsion housing is related to an anchoring system. Examiner stated that, further,

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<sup>1</sup> Emphasis added.

<sup>2</sup> Emphasis added.

the application was subject to a restriction where applicant elected without traverse to not have the propulsion system examined. Examiner stated that for the purposes of examination, the examiner is treating "propulsion housing" as --a housing--. Applicant has amended claim 10 per the examiner's suggestion. Applicant respectfully submits that the claim is in condition for allowance.

#### **IV. CLAIM REJECTIONS – 35 USC § 102**

##### **A. Examiner's Statements**

Examiner rejected claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by Semar (U.S. Patent No. 4,542,788). Examiner stated that with respect to claim 1, Semar discloses an apparatus for retaining a well tool within a wellbore and that the apparatus includes the following features:

- A first and second tapered members 24 and 26 oppositely disposed on a camming member 22 disposed between the first and second members.
- The first and second members have a contracted position (Figure 1) on the camming member not engaging the wellbore wall and an expanded position (Figure 2) engaging the wellbore wall.

The examiner stated that, regarding claim 2, the apparatus includes an actuation assembly moving the tapered members between the expanded and contracted positions. The examiner stated that, regarding claim 3, the actuation assembly includes a piston and cylinder 32 and 34. The examiner stated that, regarding claim 4, the actuation assembly includes a return spring 36 biasing the piston. The examiner stated that, regarding claim 5, the tapered members, camming member, and the actuation member are disposed on a common mandrel. The examiner stated, regarding claim 6, the tapered members are disposed on a common mandrel with the tapered members extending over 180 degrees around the mandrel (Figure 3). The examiner stated, regarding claim 7, the tapered members include tapered surfaces, a portion of which extends on each side of the mandrel (Figure 3). The examiner stated that, regarding claim 8, the tapered members and camming member have inter-engaging surfaces with the mandrel that prevent relative rotation with respect to the mandrel (3:7-18). The examiner noted that the tapered members and the camming member are locked together (Figure 3) and thus both features are prevented from rotating relative to the mandrel by the tapered members being secured to the mandrel. The examiner stated, regarding claim 11, Semar discloses an apparatus for anchoring a well tool within a wellbore. The examiner stated that the apparatus includes an extendable member 24 and 26 and a double-sided wedge device 22 to actuate the extendable member.

## **B. Law**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>3</sup> The identical invention must be shown in as complete detail as is contained in the ... claim.<sup>4</sup>

## **C. Claims 1 - 8**

Semar does not anticipate claims 1-8, as amended, because Semar does not disclose first and second tapered members oppositely disposed on a camming member disposed axially between said first and second tapered members. Semar discloses a set of slips 24 disposed on either radial side of a tapered cone 22. However, Semar does not disclose that the slips 24 are oppositely disposed on a camming member that is disposed between the slips 24 in the axial direction. In fact, Semar only discloses axial symmetry with the slips being axially aligned on either side of the tapered cone 22. Thus, Semar never discloses first and second tapered members as required by claims 1-8. Applicant therefore respectfully submits that rejection is unsupported by the art and requests that the examiner withdraw the rejection. Further, Seman does not disclose an anchor member for anchoring to a borehole wall. Seman is directed to an anchor for anchoring to the inside of casing.

## **D. Claim 11**

Semar does not anticipate claim 11 because Semar does not disclose a double sided wedge device to actuate said extendable member with first and second tapered surfaces on opposite axial sides. Semar discloses a set of slips 24 disposed on either radial side of a tapered cone 22. However, Semar does not disclose that the tapered cone 22 has first and second tapered surfaces that are on opposite sides of the tapered cone 22 in the axial direction. In fact, Semar only discloses that the tapered surface of the cone 22 is on "opposite sides", if a cone can be said to have more than one side, in the radial direction, not the axial. Thus, Semar never discloses first and second tapered surfaces as required by claim 11. Applicant therefore respectfully submits that rejection is unsupported by the art and requests that the examiner withdraw the rejection.

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<sup>3</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>4</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

## V. CLAIM REJECTIONS - 35 U.S.C. § 103

### A. Examiner's Statements

The examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Semar (U.S. Patent No. 4,542,788) in view of Baker (U.S. Patent No. 2,878,877). The examiner stated that Semar discloses all of the limitations of claim 9 except for the apparatus including biasing members forcing the tapered members and the camming member apart. The examiner stated that Baker discloses a wellbore tool retaining apparatus similar to that of Semar. The examiner stated that Baker further teaches biasing members 42 that force tapered members 19 and a camming member 20 apart as the camming member is being moved upward relative to the tapered members. The examiner stated that it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Semar to include biasing members to force the tapered members and the camming members apart as taught by Baker in order to have maintained the tapered member in a fully extended position when the camming member was moved away from the tapered members (5:18-25). One would have been motivated to make such a combination because a secure retaining or anchoring system would have been obtained, as inferred by Baker.

### B. Law

MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>5</sup> Second, there must be a reasonable expectation of success.<sup>6</sup> Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.<sup>7</sup> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>8</sup>

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<sup>5</sup> MPEP § 2142.

<sup>6</sup> MPEP § 2142.

<sup>7</sup> MPEP § 2142.

<sup>8</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

### C. Claim 9

Claim 9 is not obvious because Semar combined with Baker fails to teach or suggest all of the limitations of the claims. Claim 9 requires first and second tapered members oppositely disposed on a camming member disposed axially between said first and second tapered members. Semar discloses a set of slips 24 disposed on either radial side of a tapered cone 22. However, Semar does not disclose that the slips 24 are oppositely disposed on a camming member that is disposed between the slips 24 in the axial direction. In fact, Semar only discloses axial symmetry with the slips being axially aligned on either side of the tapered cone 22. Baker is similar in that the tapered members 19 are on opposite radial sides of the camming member 20. Thus, there is no *prima facie* case of obviousness because Semar and Baker fail to teach or suggest all of the limitations of the claims. Applicant therefore respectfully suggests that the rejection is unsupported by the art and requests that the examiner remove the rejection.

## VI. ALLOWABLE SUBJECT MATTER

The Examiner stated that claim 10 is allowable.

## CONCLUSION

Applicant respectfully requests reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

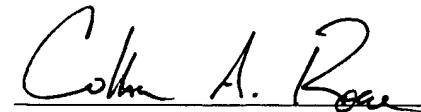
In the course of the foregoing discussions, applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although Applicant may have amended certain claims, Applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

Appl. No. 09/845,473  
Amdt. dated September 7, 2004  
Response to Office action of June 15, 2004

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-19601) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,  
CONLEY ROSE, P.C.



Collin A. Rose  
Collin A. Rose  
Reg. No. 47,036  
P.O. Box 3267  
Houston, TX 77253-3267  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)

Attachments

Appl. No. 09/845,473  
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Response to Office action of June 15, 2004

**Appendix**

**Amendments to the Drawings:**

Attached are amended sheets of drawings for Figures 3, 5, 7, 8, 10, and 16-18. The amendments to the Figures are shown in red. In Figure 3, the lead line to the annulus 83 has been corrected. Reference numeral 162 in Figure 5 has been changed to 162a,b. Reference numerals 102a,b have been added to Figure 7 and Reference numerals 122a,b have been added in Figure 8. Likewise reference numerals 168 and 166a have been added to Figure 10. Further reference numerals have been added to Figures 16-18 at the request of the Examiner. Applicant requests that these drawing amendments be approved.

Attachment: Annotated Sheet Showing Changes



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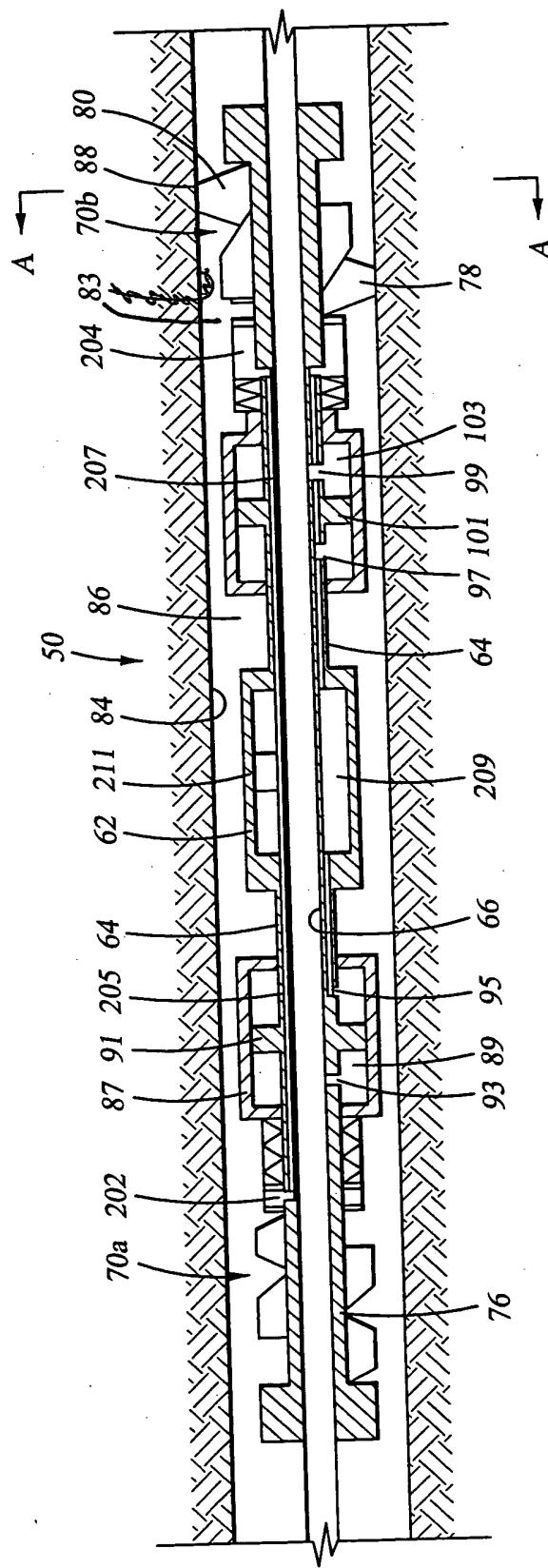


Fig. 3

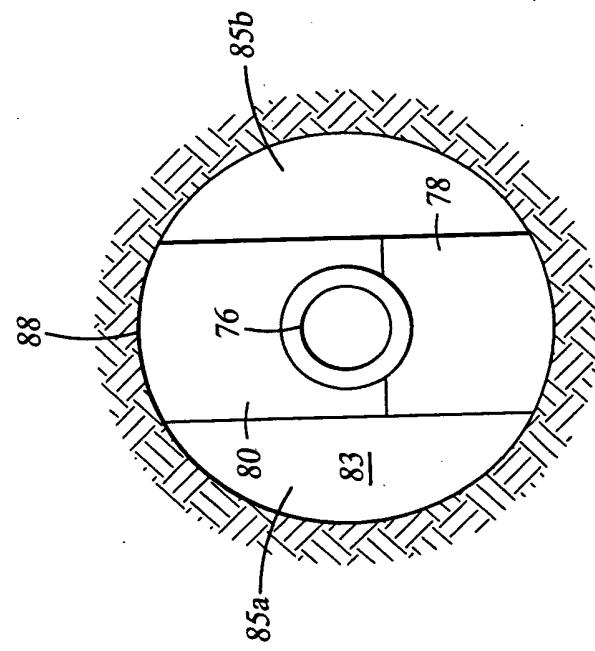


Fig. 4



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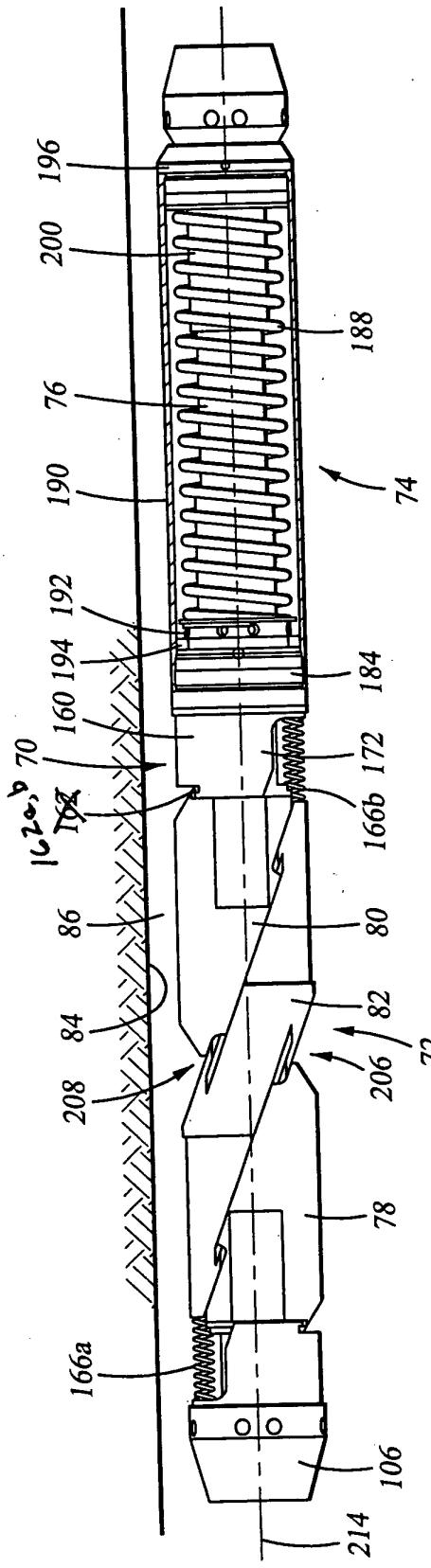


Fig. 5

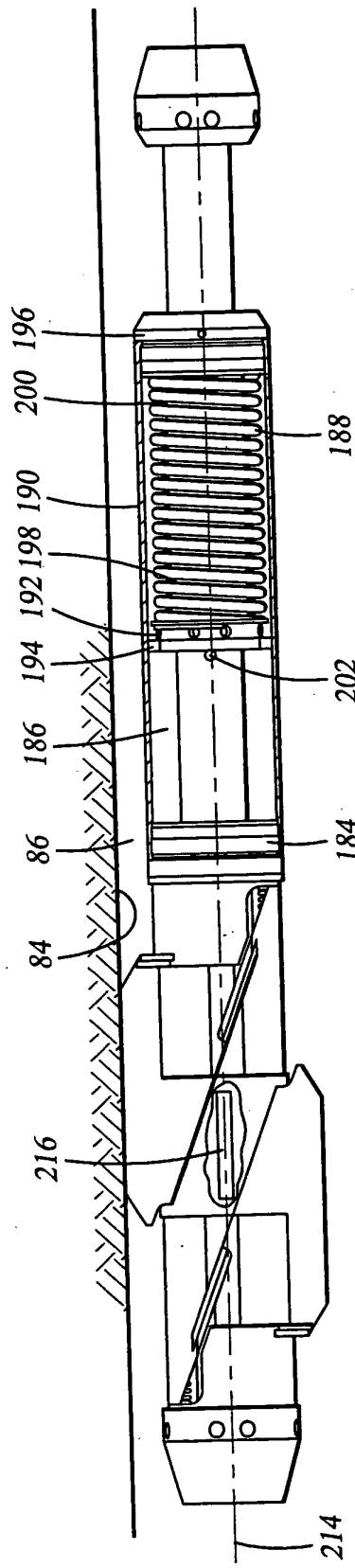


Fig. 6

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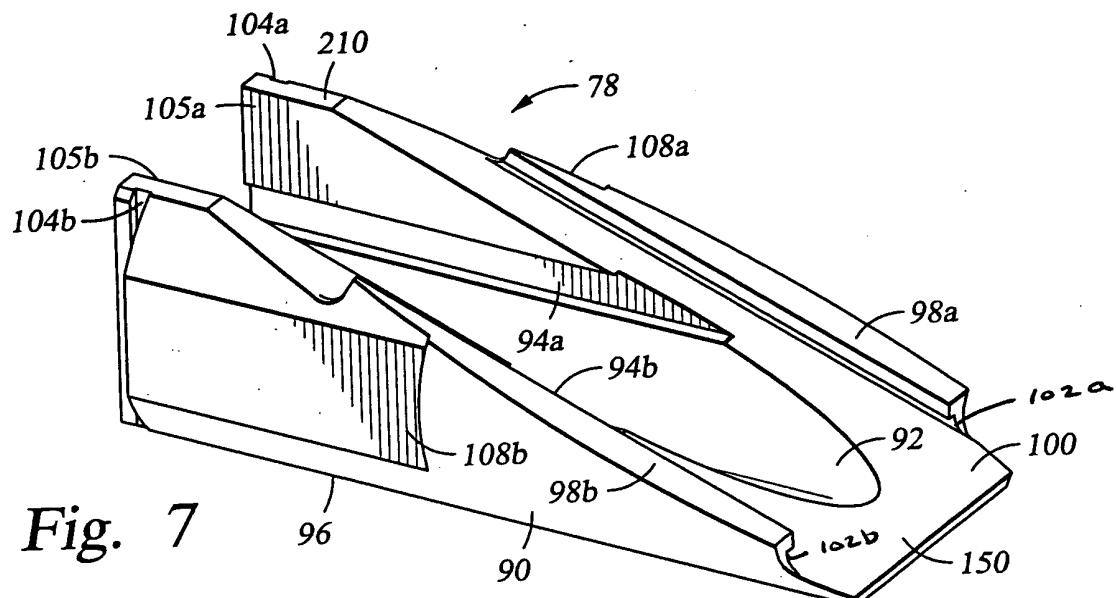


Fig. 7

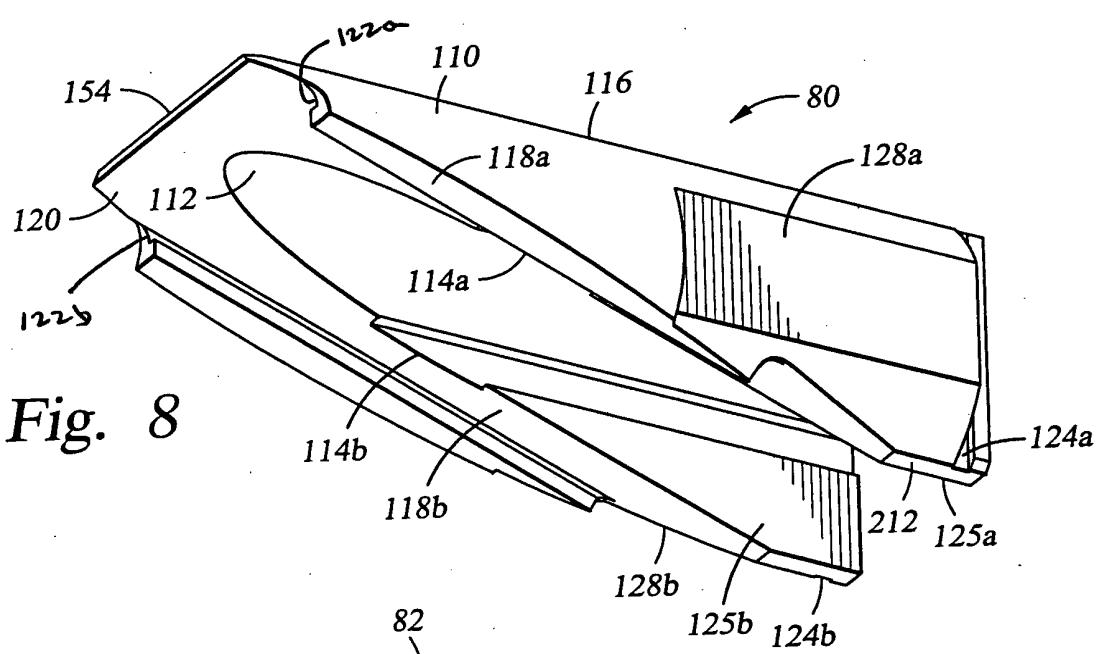


Fig. 8

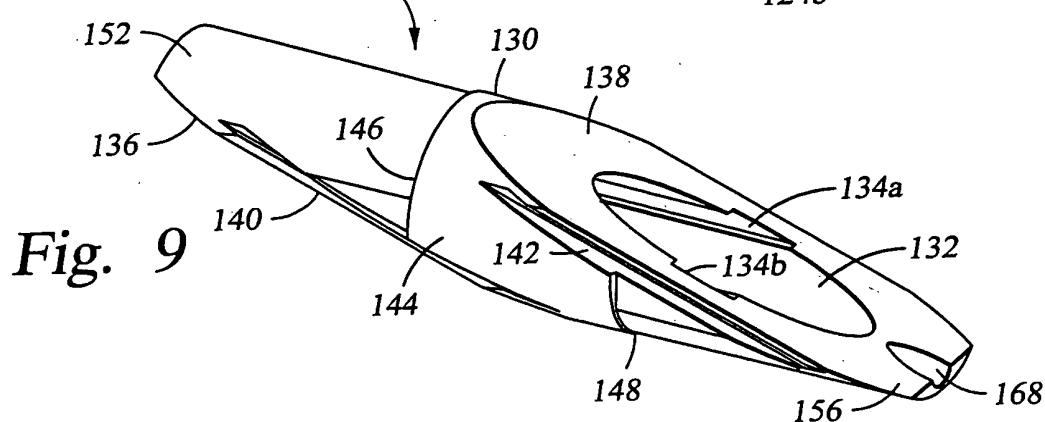
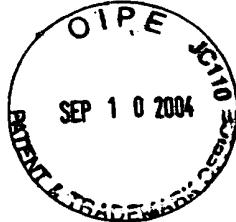


Fig. 9



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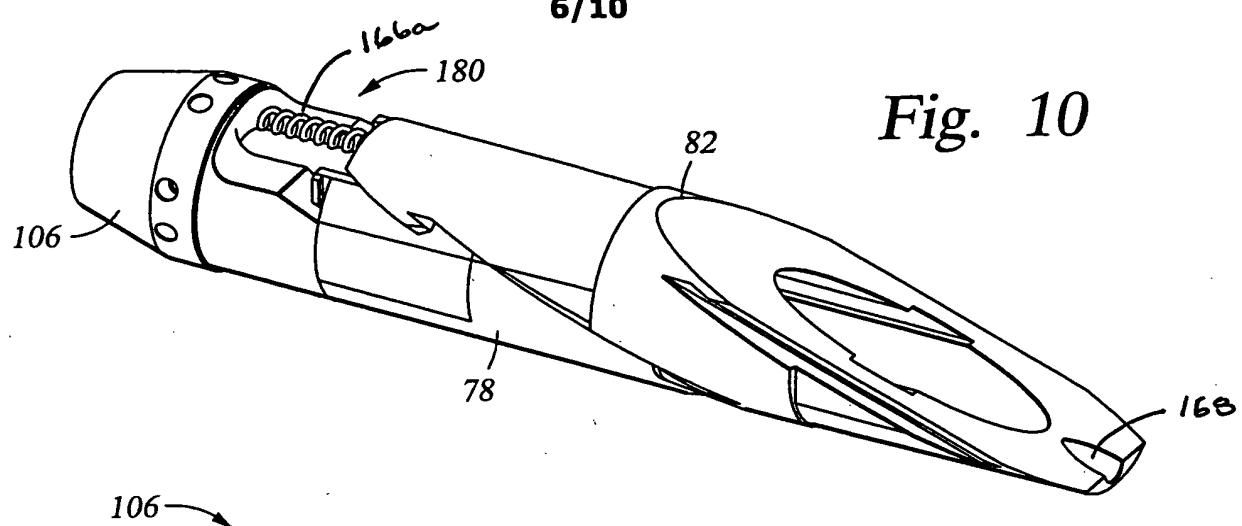


Fig. 10

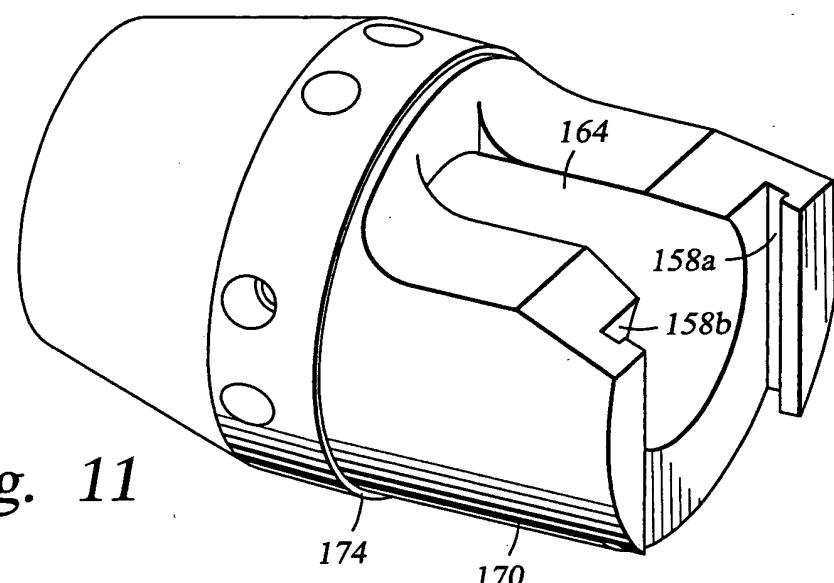


Fig. 11

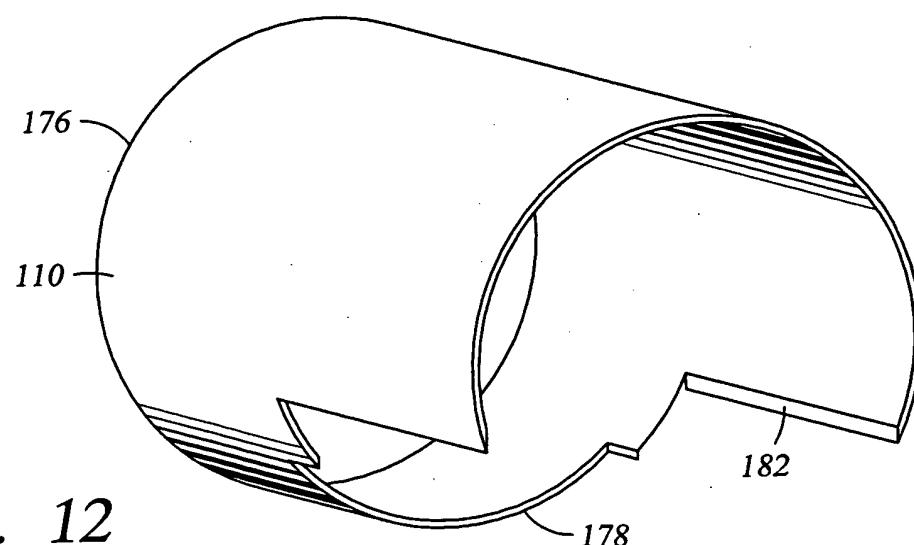


Fig. 12

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Fig. 16

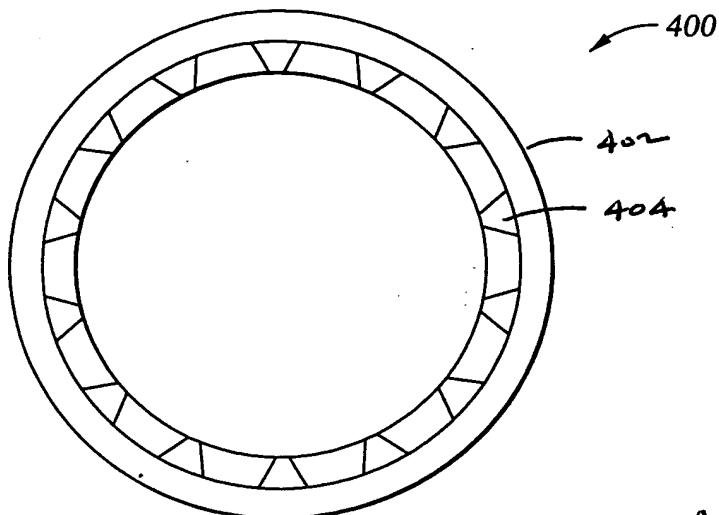


Fig. 17

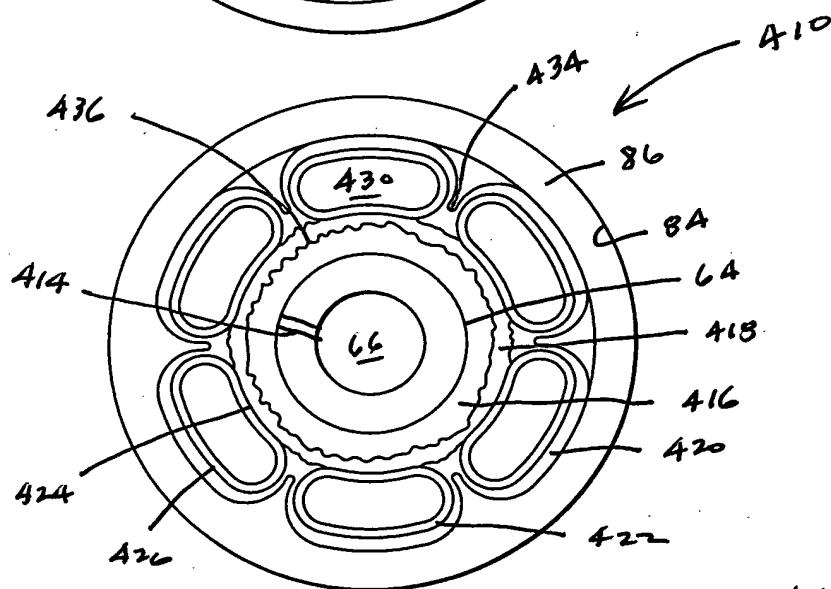


Fig. 18

